

82



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,638	09/22/2000	HISAO NAKAGAWA	862.C2006	8163
5514	7590	08/12/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			NGUYEN, MAIKHANH	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,638

Applicant(s)

NAKAGAWA ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/17/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 06/03/2005 to the original application filed 09/22/2000.
2. Claims 1-2 and 4-10 are currently pending in this application. Claims 1, 2, 4-6, and 8-10 have been amended. Claims 3, 11-68 have been canceled. Claims 1 and 9-10 are independent claims.

Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

Claims 1-2 and 4-10 remain rejected under 35 U.S.C. 102(e) as being anticipated by

Igarashi et al. (U.S. 6,484,195 – filed 02/2000, foreign priority filed 07/1996).

As to independent claim 9:

Igarashi teaches a method of controlling an information processing apparatus for submitting document information including a plurality of images via a network (*e.g., control apparatus to exchange information ... using a network; col.3, lines 25-33*), comprising:

- a. storing input schedule information of predetermined image input means (*e.g., the information received by the receiving includes image sensing schedule information; col.24, lines 51-53*);
- b. storing an image obtained in accordance with the schedule information (*e.g., stores the obtained image ... the image obtained by programmed image sensing; col.5, lines 24-51 /the image data, obtained by programmed image sensing and stored as a file; col.8, lines 34-43 and Fig.5*);
- c. designated an image among the plurality of images in the document information to be changed by an image newly stored in the image storage step (*if the designated image format is "mpg", a plurality of image data registered ...then the images are compressed by the moving-image processor 2121, and the compressed moving image data are returned ... to the external device; col.11, lines 47-53*); and
- d. creating new document information by substituting the designated image in the document information by the image stored in said image storage steps (*e.g., an HTML document is generated with image data description ...perform the programmed image sensing, and stores the obtained image data ...transferred in the designated format; col.5, lines 10-35*).

As to independent claim 10:

It is directed to a storage medium for implementing the method of claim 9, and is similarly rejected under the same rationale.

As to independent claim 1:

It is directed to an information processing apparatus for performing the method of claim 9, and is similarly rejected under the same rationale. Additionally, Igarashi further teaches image input means (*e.g., video-image input unit 1018; Fig.1*).

As to dependent claim 2:

Igarashi teaches transferring the document information created by the document creation unit to a network server (*e.g., the client transfers a URL description to the server; col.21, lines 57-67*).

As to dependent claim 3:

Igarashi teaches designating an image in the old document information to be changed by an image newly stored in the image storage means (*e.g., converts the image stored in the image memory with the reservation code into a newly designed format data; col.5, lines 24-59/col.7, lines 5-17*).

As to dependent claim 4:

Igarashi teaches displaying control means for displaying the changed image in a different pattern (*col.8, lines 11-34*).

As to dependent claim 5:

Igarashi teaches when the image among the plurality of images in the document information is designated (*col.11, lines 47-53*), displaying that image in a pattern different from other images (*col.17, lines 4-54*).

As to dependent claim 6:

Igarashi teaches storing an image prepared in advance, and submitting an image among the plurality of images in the document information, which is not changed by the image prepared in advance (*Fig.20 and the associated text*).

As to dependent claim 7:

Igarashi teaches the document information is HTML document information (*e.g., HTML document; col.4, lines 35-38/col.5, lines 10-35*).

As to dependent claim 8:

Igarashi teaches the input schedule includes an image sensing position and time (*col.4, lines 1-58*).

Response to Arguments

4. Applicant's arguments filed 08/18/2004 have been fully considered but they are not persuasive.

Applicant argues that *Claims 1, 9, and 10 variously recited... Igarashi et al. fails to disclose or suggest at least the above-discussed combinations of claimed features as cited, inter alia, in claims 1, 9, and 10.* (Remarks, page 5)

In response, this response by Applicant is insufficient to satisfy the requirement of specific argument to have the claims considered for patentability; in accordance with 37

C.F.R. § 1.111 Applicant must distinctly and specifically point out "how the language of the claims patentably distinguishes them from the references".

Accordingly, the cited references do teach the recited claim limitations as shown through the mapping provided in the claim rejections.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Winter et al. U.S. Patent No. 5,875,304 Issued: Feb. 23, 1999

Shinohara U.S. Publication 2003/0149934 A1 Pub. Date: Sep. 26, 2002

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2176

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am - 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
8/7/2005